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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/593,624

04/19/2007

Shunji Suzuki

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38834

7590

05/13/2009

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EXAMINER

HARRIS, GARY D

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

05/13/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/593,624	<b>Applicant(s)</b> SUZUKI ET AL.	
	<b>Examiner</b> GARY D. HARRIS	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4 is/are pending in the application.
- 4a) Of the above claim(s) 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 & 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments, see remarks, filed 4/23/2009, with respect to the rejection(s) of claim(s) 1-3 under 35 U.S.C. have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US Sagawa et al. US 5,194,098 and further in view of Nomura et al. US 2004/0094237.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 & 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Sagawa et al. US 5,194,098, and further in view of Nomura et al. US 2004/0094237.

As to Claim 1, US Sagawa et al. US 5,194,098 discloses in the 5th embodiment a rare earth film Fe-B-R where R is 8-30 percent, and consisting of Yttrium (a rare earth lanthanide element), Fe and B in which the crystals are present (Col. 3, Line 19-26). The film alloys are amorphous in nature (composite texture) and discloses that the process of making includes a sintering process to produce any desired shape and size (Col. 5, Line 39-46). Sagawa discloses that the crystal grain sizes range from 2 to 40

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microns and increase the Hc of various materials based on their critical size and would overlap applicants range (Col. 6, Line 41-46). Nevertheless, the subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made, since it has been held that choosing the overlapping portion, of the range taught in the prior art and the range claimed by the applicant, has been held to be a *prima facie* case of obviousness, see *In re Malagari*, 182 USPQ 549.

With regard to the thickness range, the Examiner deems that it would have been obvious to optimize the thickness of the final alloy depending on the desired end use, especially given the size ranges of the particulate and the fact that the powder can be compressed and sintered into any desired shape and size (Col. 5, Line 39-46 and Examples).

Sagawa et al. US 5,194,098 does not disclose  $R_2Fe_{14}B$  crystals. However, Nomura et al. US 2004/0094237 discloses that R-Fe-B magnets are structured with a hard magnetic phase of  $R_2Fe_{14}B$  is present as the primary phase and grain boundary moieties surround the primary phase grains (Paragraph 5). The  $R_2Fe_{14}B$  phase would necessarily/inherently be present in the Sagawa invention.

As to Claim 2, Sagawa et al. US 5,194,098 discloses the material is amorphous which would inherently/necessarily have a random orientation.

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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY D. HARRIS whose telephone number is (571)272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Bernatz, acting SPE for Carol Chaney, can be reached on 571-272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gary Harris  
/G. D. H./  
Examiner, Art Unit 1794

/Kevin M Bernatz/  
Acting SPE of Art Unit 1794

May 11, 2009